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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,175	09/15/2003	Dean A. Smith	COL-014	9441

7590  
A.J. O'Lenick, JR.  
2170 Luke Edwards Road  
Dacula, GA 30019

03/06/2006

EXAMINER

MCINTOSH III, TRAVISS C

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/662,175

Applicant(s)

SMITH ET AL.

Examiner

Traviss C. McIntosh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The Amendment filed November 5, 2005 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 8-14 have been added

Claims 1-7 have been canceled.

Remarks drawn to rejections of Office Action mailed October 31, 2005 include:

Claim objection: which has been overcome by applicant's amendments and has been withdrawn.

Specification objections: which have not been addressed by applicants and is maintained for reasons of record.

112 2<sup>nd</sup> paragraph rejections: which have not been addressed by applicants and have been maintained for reasons of record.

112 1<sup>st</sup> paragraph rejection: which has been overcome by applicant's amendments and has been withdrawn.

An action on the merits of claims 8-14 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

### ***Specification***

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with information which is not clear, concise and exact. Examples of some unclear, inexact or verbose information used in the specification are: the table on page 19 indicates the alkyl and OH values for compounds from examples 2-9, however, only compounds 1-8 were made with this method; applicants methods on page 20 use a reactant with R", which is not defined in the disclosure; the results on page 27 indicate that "application example 1 demonstrated exceptional antimicrobial activity against all four test organisms...", however, it is noted that application example 1 had no activity on 1 of the 4 test organisms, and only had very slight activity against another of the test organisms in 1 concentration tested. Moreover, it is noted that the examiner has not been able to determine exactly what compounds were tested. It appears that applicants made 8 glycoside compounds (examples 1-8) and then made 6 reactants (examples 9-14) and subsequently reacted various compounds from examples 1-8 with the reactants of examples 9-14 to provide final products 15-26, however, the examiner has not been able to determine as to exactly what compounds were tested. The specification should be revised in it's entirety carefully in order to comply with 35 U.S.C. 112, first paragraph.

It is noted that applicants failed to respond to this objection as set forth in the previous office action.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,881,710 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both patents comprise administering the same compounds. It is noted that the ‘710 patent is drawn to methods of cleansing and condition hair and skin and the instant application is drawn to methods of inhibiting microbial growth, however, upon review of the ‘710 patent to determine what the methods of cleansing encompass, the patent states the products provide antimicrobial activity (see abstract).

The above rejection is, in part, based on the specification of a previously issued patent, rather than the claims. In support of the use of this material, the examiner notes the following excerpt from MPEP section 804:

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When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. In *re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. In *re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined."

Thus, the courts have held that it is permissible to use the specification in determining what is included in, and obvious from, the invention defined by the claim on which the rejection is based. This is true even where elements are drawn from the specification describing the claimed invention which are not elements in the claim itself. As set forth above, a terminal disclaimer may be used to overcome the instant rejection.

### ***Claim Rejections - 35 USC § 112***

Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is confusing in the fact that the claim is drawn to a method of inhibiting microbial growth comprising contacting a substrate with an antimicrobial composition "conforming to the following structure:", and then the claim lists structure (a) **and** (b). How can a composition conform to a structure of 2 divergent molecules? Does applicant intend the

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composition to be a combination of the 2 agents, or to comprise only one or the other of the two agents? Moreover, it is noted that if applicants intend the composition to only include 1 of the 2 agents, then it is unclear how the claim can comprise a composition, as it would only contain 1 item, and that is a compound, not a composition. Upon review of the specification, the examiner has been unable to determine exactly what compounds are being administered. It is believed that the composition administered “comprises structures (a) or (b)”.

It is noted that applicants failed to respond to this rejection as set forth in the previous office action.

All claims which depend from an indefinite claim are also indefinite. *Ex parte Cordova, 10 U.S.P.Q. 2d 1949, 1952 (P.T.O. Bd. App. 1989).*

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

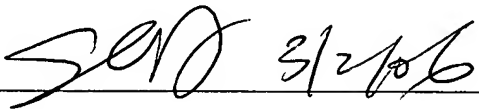
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Traviss C. McIntosh III  
March 2, 2006

Shaojia A. Jiang  
Supervisory Patent Examiner  
Art Unit 1623



A handwritten signature in black ink, appearing to read 'S. Jiang', followed by the date '3/2/06'. The signature is written over a horizontal line.